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JAMES D. FORNARI, ESQ
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1020 PARK AVENUE
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EXAMINER

KIM, PAUL

ART UNIT	PAPER NUMBER
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2161

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/619,101

Applicant(s)

IRVING ET AL.

Examiner

Paul Kim

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2161

DETAILED ACTION

1. This Office action is responsive to the following communication: Amendment filed on 14 August 2007.
2. Claims 2-21 are pending and present for examination. Claims 2 and 12 are in independent form.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 August 2007 has been entered.

Response to Amendment

4. Claims 2 and 12 have been amended.
5. No claims have been cancelled.
6. No claims have been added.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 2-9 and 12-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews et al (USPGPUB No. 2003/0050986, hereinafter referred to as MATTHEWS), filed on 13

Art Unit: 2161

September 2002, and published on 13 March 2003, in view of Sutcliffe et al (US Patent No. 6,249,282, hereinafter referred to as SUTCLIFFE), filed on 10 January 2000, and issued on 19 June 2001, and in further view of Hockey (USPGPUB No. 2004/0064515, hereinafter referred to as HOCKEY), filed on 29 August 2001, and published on 1 April 2004.

9. **As per independent claims 2 and 12, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:**

An apparatus for electronic collaboration in an environment including a plurality of communities, each of the plurality of communities having a plurality of live users and at least one community administrator, the apparatus comprising:

- a community creation database that receives and stores preliminary profile data associated with a candidate user, the preliminary profile data indicating an interest of the candidate user in joining one of the plurality of communities {See MATTHEWS, Para. 0026, lines 6-8, wherein this reads over "SMC module is configured, for example. To create a user and user profile in database"; and Para. 0028, lines 1-2, wherein this reads over "[d]atabase 130 is configured to store member attributes and group attributes"};

- a first filter that validates the preliminary profile data, whereupon the candidate user associated with validated preliminary profile data is deemed acceptable for participation in said one of the plurality of communities, the first filter tailored to said one of the plurality of communities, wherein the candidate user associated with the validated preliminary profile data thereby becomes a live user of the plurality of live users in said one of the plurality of communities {See MATTHEWS, Para. 0046, wherein this reads over "a private group can be joined by members of the community as approved The GA may, for example, restrict access to the group to a predefined list of users"; and Para. 0049, wherein this reads over "the SPC module, which compares the user's membership attributes to the group's permission criteria to verify whether or not the user has permission to join this group"};

wherein the live user creates at least one profile, wherein the profile includes descriptive information relating to the live user {See MATTHEW, Para. 0039, wherein this reads over "[t]he member's name or code may be associated in database 130 with additional member attributes"}, said descriptive information includes a first data corresponding to a set of attributes predefined by at least one of the plurality of communities and a second data corresponding to a second set of attributes entered by said candidate user {See MATTHEW, Paras. 0037-0041};

- a search engine that searches for another of the plurality of live users in said one of the plurality of communities {See SUTCLIFFE, C7:L58-C8:L12, wherein this reads over "[a] first user can request a search of the database for other users based on characteristic and criteria data"} with which to communicate {See SUTCLIFFE, C4:L7-10, wherein this reads over "a user may choose a particular means to contact another user, such as by e-mail"}, based on at least a portion of said second data; and

- a second filter that monitors communications between the plurality of live users within said one of the plurality of communities, the second filter including at least

Art Unit: 2161

a flagging filter that flags communications between the plurality of live users based on an analysis of at least a textual portion of said communications according to predetermined criteria {See HOCKEY, Para. 0109, wherein this reads over "the thresholds and attributes used for distinguishing a flagged message may be user-configurable"}, wherein flagged communications are reviewed prior to release to their intended recipient {See HOCKEY, Para. 0115, wherein this reads over "other options include changing the message attributes so that it may not be delivered or opened other than by a system administrator, and/or may place the file in a 'quarantine zone'"}

While MATTHEWS fails to expressly disclose a search engine, SUTCLIFFE provides a method for searching the database for other users based on characteristic and criteria data. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above invention suggested by MATTHEWS by combining it with the invention disclosed by SUTCLIFFE. That is, the inclusion of the disclosed invention in SUTCLIFFE would provide for the searching of members of community according to the descriptive information related to each of the live users.

One of ordinary skill in the art would have been motivated to do this modification so that a live user may search for and find other live users according to the descriptive information.

Secondly, while MATTHEWS fails to expressly disclose a second filter that monitors communications between a plurality of live users, HOCKEY discloses a system wherein messages may be flagged according to certain thresholds and attributes. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above invention suggested by MATTHEWS by combining it with the invention disclosed by HOCKEY. That is, the modification of the invention disclosed in MATTHEWS by the invention disclosed by HOCKEY would allow for email message or other types of communications to be monitored for Spam and other inappropriateness.

One of ordinary skill in the art would have been motivated to do this modification so that message containing Spam and other inappropriateness may be filtered and intercepted such that said message are not delivered to their intended recipients.

10. **As per dependent claims 3 and 13**, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:

The apparatus of claim 1, wherein validation of the preliminary profile data includes an administrator of said one of the plurality of communities approving the candidate

Art Unit: 2161

user {See MATTHEWS, Para. 0045, hereinafter referred to as "[t]he GA may also have authority to manage group membership, wherein members may be added to or deleted from a group membership list by the GA"}.

11. **As per dependent claims 4 and 14, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:**

The apparatus of claim 1, wherein validation of the preliminary profile data includes automatic validation based on one or more attributes of the preliminary profile data {See MATTHEWS, Para. 0044, wherein this reads over "such requests may be processed by an automated approval process"}.

12. **As per dependent claims 5 and 15, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:**

The apparatus of claim 4, wherein the one or more attributes include one or more of previous approval by an administrator of a specific other one of the plurality of communities and previous validation as a live user in said one of the plurality of communities {See MATTHEWS, Para. 0043, wherein this reads over "[r]equests may also be denied for persons who have in the past violated community rules"}.

13. **As per dependent claims 6 and 16, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:**

The apparatus of claim 1, wherein the preliminary profile data indicates an interest of the candidate user in joining at least one other of the plurality of communities {See MATTHEWS, Para. 0047, wherein this reads over "searches and/or filters may assist members in finding a group to join"}.

14. **As per dependent claims 7 and 17, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:**

The apparatus of claim 1, wherein the at least one profile includes one or more of:

a group profile that is accessible to the plurality of live users in said one of the plurality of communities {See MATTHEWS, Figure 4},

an individual profile that is not accessible to the plurality of live users in said one of the plurality of communities, and

a project profile that includes blind contact information regarding the live user.

It is noted that because the "an individual profile" and "a project profile" were optionally recited within the claim, they will not be give consideration for the remainder of this Office action nor will prior art be applied to said optionally recited elements..

Art Unit: 2161

15. **As per dependent claims 8 and 18**, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:

The apparatus of claim 1, wherein the search engine also searches for live users in communities other than said one of the plurality of communities {See SUTCLIFFE, C7:L58-C8:L12, wherein this reads over "[a] first user can request a search of the database for other users based on characteristic and criteria data"}.

16. **As per dependent claims 9 and 19**, MATTHEWS, in combination with SUTCLIFFE and HOCKEY, discloses:

The apparatus of claim 1, wherein the at least one profile of the live user includes one or more labels represent the descriptive information relating to the live user and wherein the search engine searches for another of the plurality of live users using labels associated with profiles of the plurality of live users {See SUTCLIFFE, C5:L22-67, wherein this reads over "characteristic and other data elements"}.

17. **Claim 10-11 and 20-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over MATTHEWS, in view of SUTCLIFFE, in further view of HOCKEY, and in further view of Official Notice.

18. **As per dependent claims 10 and 20**, the Examiner takes Official Notice that it would have been widely known to one of ordinary skill in the art that profiles be created in a plurality of languages (e.g. English, Spanish, Chinese, French, German, and etc.) such that communities may span a plurality of international backgrounds.

19. **As per dependent claims 11 and 21**, the Examiner takes Official Notice that it would have been widely known and apparent to one of ordinary skill in the art to associate languages with a profile and implement a search according to the language characteristic of a plurality of live users.

Response to Arguments

20. Applicant's arguments filed 14 August 2007 have been fully considered but they are not persuasive.

a. Claim Rejections under 35 U.S.C. 103

Applicant asserts the argument that "Matthews fails to disclose a method or system where a candidate user possesses the ability to enter any distinguishing information he or she

desires." See Amendment, page 8. The Examiner respectfully disagrees. Applicant is directed to Paragraph [0038] of Matthews et al which discloses that "the CA may create members from particular users identified in the community" and that "a member may have the authority to create other members within the same community." Furthermore, it is noted that Paragraphs [0039] and [0040] disclose that "the user may be primarily identified by a code and creating a member may include adding the code to a list of member codes in the database" wherein the code may be an "identifier/indicia suitably configured to allow the consumer to interact or communicate with the system." Accordingly, Matthews indeed would disclose a method or system wherein a candidate user possesses the ability to enter an identifier or indicia (i.e. the distinguishing information) that the user desires.

Secondly, Applicant asserts the argument that "Matthews fails to disclose a method or system wherein such information may be used by the system to pair the candidate user with one or more other users that have interests similar to the information entered by the candidate user." See Amendment, page 8. The Examiner respectfully disagrees in that Matthews et al discloses that "a group within the community may be defined by any commonly shared characteristic." See Matthews et al, Paragraph [0041]. That is, as disclosed by Matthews et al, "the CA may create members from particular users identified in the community. All homeowners, for example, within a homeowner's association may be made members of that community." See Matthews et al, Paragraph [0038].

Thirdly, Applicant asserts the argument that "Matthews fails to disclose a method or system that provides a candidate user with the ability to enter attributes other than those predefined by the system." See Amendment, page 9. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 2161

Fourthly, Applicant asserts the argument that "Matthews fails to disclose the ability to search and pair users based on this unique information provided by each user." See Amendment, page 9. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner notes that said feature was cited to be disclosed by Sutcliffe et al in the prior Office Action.

Lastly, Applicant asserts the argument that "Matthews neglects to mention any monitoring of the communications between the users or flagging of such communications in any way." See Amendment, page 9. The Examiner respectfully disagrees in that Matthews et al discloses that a group administrator may "have authority to monitor interaction on message boards and/or to remove inappropriate content from the message boards." See Matthews et al, Paragraph [0045]. Additionally it is noted that Hockey also discloses that messages may be flagged or quarantined such that only an administrator may have accesses to said flagged messages.

For the aforementioned reasons above, the rejections of claims 2-21 are sustained under 35 U.S.C. 103.

Conclusion


21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kim whose telephone number is (571) 272-2737. The examiner can normally be reached on M-F, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2161

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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